

### **REMARKS**

Claims 1-3, 5-6, 9-13, 17, 19-20, and 27-43 are pending in the subject application. Of these, claims 1-3, 5, 6, 9, 11-13, 17, 19, and 27-43 are indicated as being allowed. Applicants have hereinabove amended claims 10, 20, and 37 without prejudice or disclaimer to applicant's right to pursue the subject matter of these claims in a future continuation or other application. Claim 37 has been amended to correct an obvious typographical error. Applicants maintain that the amendments to the claims raise no issue of new matter, and respectfully request entry of this Amendment. Accordingly, after entry of this Amendment, claims 1-3, 5-6, 9-13, 17, 19-20, and 27-43 will be pending and under examination.

### **Objection to the Disclosure**

On page 2 of the March 8, 2004 Office Action, the Examiner objected to the disclosure of the specification as containing an informal sequence listing that is not in the proper format. The Examiner stated that cancellation of this information would be remedial, in view of the fact that a properly formatted sequence listing was subsequently filed and entered into the specification. Applicants have hereinabove amended the specification to remove the informal sequence listings. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

### **Rejection Under 35 U.S.C. §112, Second Paragraph**

On page 2 of the March 8, 2004 Office Action, the Examiner rejected claims 10 and 20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. The Examiner further rejected claims 10 and 20 under 35 U.S.C. 11, second paragraph, as being indefinite for failing to recite a proper Markush group. In order for the claims to be definite, the Examiner alleged, they must recite the proper Markush language, wherein the members of the Markush group are "selected from the group consisting of," followed by the listing of the members of the group. The Examiner further noted that the conjunction "and" must follow the penultimate member of the group. The Examiner stated that in the instant case, the claims have both

conjunctions "or" and "and" present in the claim language. The Examiner alleged that this makes the claims indefinite because it is unclear if the selection is made from either (a) the whole collection of a radioactive label, a non-radioactive isotopic label, a fluorescent moiety, a visibly-detectable moiety and a releasable substrate or (b) a co-factor for a chemical and enzymatic reaction, or if each of the individual items is a single group (i.e. pick one from either (a) or (b) set forth above). The Examiner pointed out that it would be remedial to indicate the following language, if the latter is true: "... wherein said cap-labeled mRNA substrate is labeled at the cap of said cap-labeled mRNA substrate by a label selected from the group consisting of said cap-labeled mRNA substrate by a label selected from the group consisting of a radioactive label, a non-radioactive isotopic label, a fluorescent moiety, a visibly-detectable moiety, a releasable substrate, a co-factor for a chemical reaction, and a co-factor for an enzymatic reaction."

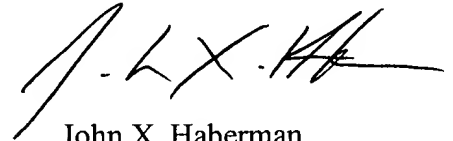
In response applicants have non-narrowingly amended claims 10 and 20 to more precisely recite the subject matter claimed. Amended claims 10 and 20 properly recite a Markush group and clearly claim the subject matter. Accordingly, applicants maintain that amended claims 10 and 20 comply with the requirements of 35 U.S.C. §112, second paragraph, and respectfully request that that Examiner reconsider and withdraw this ground of rejection.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Applicants: Jeffrey Wilusz et al.  
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No fee, apart from the \$55.00 fee for a one-month extension of time is deemed necessary in connection with the filing of this Amendment. However, if such a fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 08-2461.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. L. X. Haberman', with a long horizontal stroke extending to the right.

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